

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed September 23, 2003. Claims 45-52 remain pending in the present application. Reconsideration and allowance of the application and presently pending claims 45-52 are respectfully requested.

A. Response To Claim Rejections Under 35 U.S.C. Section 102**1. Claims 45, 46, 48-50 and 52**

Independent claims 45 and 50, as well as dependent claims 46, 48, and 49 which depend from claim 45, and dependent claim 52 which depends from claim 50 have all been rejected under 35 U.S.C. Section 102(b) as allegedly anticipated by Theising, U.S. Patent 5,181,446. Applicants respectfully traverse these rejections because the Theising reference does not disclose all of the elements of these claims as discussed more fully below.

a. Claims 45 and 50

For a proper rejection of a claim under 35 U.S.C. Section 102(b), the cited reference must disclose all elements of the claim. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).*

Independent claims 45 and 50 of the present application each recite the element: at least one annular bearing situated in the housing, the annular bearing receiving the rotatable portion such that the locking handle is rotatably supported only by the annular bearing to eliminate direct contact between the rotatable portion and the housing, wherein the rotatable portion rotates within the annular bearing upon actuation of the handle portion to move the rod, and thus the locking pawl, towards the head assembly.

Independent claims 45 and 50 are allowable for at least the reason that Theising does not disclose, teach, or suggest the features listed above from claims 45 and 50.

i. Prior Discussions Regarding "Annular Bearing"

Previous Office Actions, including the Office Action dated December 3, 2001 (Paper No. 12) acknowledged that Theising *did not disclose* the "annular bearing." In Paper No. 12, the Examiner specifically stated that "Theising '446 lacks at least one annular bearing as claimed, and more specifically, two annular bearings." Paper No. 12, at p. 5.

However, the Office Action dated February 3, 2003 (Paper No. 16), contrarily asserted that "Theising '446 discloses two annular bearings (e.g., 65)." Paper No. 16, at p. 4. The February 3, 2003 Office Action argued that "[a]s best understood from Theising '446, there is a round portion (e.g., 65) on each side of the threadable interconnection (61) of rod (55). These bearing portions (e.g., 65) are clearly annular since they are ringed shaped and include a round outer surface which slides against curved element (67) and an opening through which the camming portion extends." Paper No. 16, at p. 4.

Applicants traversed this argument, pointing out that "the office action appears to equate the spherical portion 65 discussed in the written description and shown in Figures 2 and 3 of Theising with the annular bearings recited in the present claims." Paper No. 17, at p. 7. As noted by the Applicants, "[t]he office action states the spherical portion 65 is 'ring shaped.' However, there is no disclosure or suggestion [in Theising] of the *spherical* portion being ring shaped – it is spherical." Paper No. 17, at p. 8 (emphasis in original).

Moreover, as Applicants noted, "in Theising, the 'spherical portion 65 rotates in a complementary shaped curved element 67...' Theising at col 6, ll. 30-32." By contrast, the

"structure recited in the present claims seeks to avoid this direct contact with the rotating portion of the locking handle." Paper No. 17, at p. 8.

ii. **The Current Rejection**

The current Office Action appears to set forth a similar position to that set forth in the February 3, 2003 Office Action, asserting that Theising discloses a "rotatable portion designated by the cross-hatched portion surrounding the threaded portion in Figure 2, which rotatable portion is shown in Figure 1 extending through both annular portions. Paper No. 20, at p. 3. The Office Action states that "the Examiner's position is that the cross-hatched portion shown in Figure 2 of Theising through which the rod is threaded corresponds to the claimed rotatable portion, and portions 65 of Theising correspond to the claimed annular bearings. A closer look at Figures 1 and 2 of Theising shows that there are two such bearing members 65 on either side of the rod 55." Paper No. 20, at p. 5-6.

iii. **The Office Action Incorrectly Equates A Spherical Portion In Theising To The At Least One Annular Bearing In the Present Application**

Applicants respectfully suggest that the Examiner's initial view of Theising (that Theising does not disclose the annular bearing) is the correct view, and that the current Office Action misapprehends Theising. The current Office Action improperly equates the spherical portion 65 discussed in the written description of Theising and shown in Figures 2 and 3 of Theising with two "bearing members 65 on either side of the rod 55."

As an initial matter, the written description of Theising consistently describes the spherical portion 65 as spherical, not ring shaped. Similarly, nowhere in Theising is the spherical portion 65 referred to in anything other than the singular tense – there is simply no reference, disclosure, teaching, or suggestion in the written description of the *multiple*

"bearing members 65" that the Office Action appears to infer from Theising. *See C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349, 48 USPQ2d 1225 (Fed. Cir. 1998) ("[A] finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device."); *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 1560, 225 USPQ 253 (Fed. Cir. 1985) (Instruction that the claims are invalid if the prior art discloses "substantially the same things" as the claims is legal error).

Applicants respectfully submit that there is no support for the Office Action's assertion that "portions 65 of Theising correspond to the claimed annular bearings" and that Theising does not disclose the annular bearing as claimed in claims 45 and 50. *Id.* Accordingly, Applicants request that this rejection be withdrawn and the claims allowed.

iv. The Office Action's Heavy Emphasis On Figure 1 Of Theising Is Misplaced As Figure 1 Of Theising Does Not Appear To Show The Spherical Portion

The Office Action places a great deal of emphasis on Figure 1 of Theising to support the Office Action's re-designation of the spherical portion 65 disclosed in Theising to multiple "bearing members 65." According to the Office Action, "[a] closer look at Figures 1 and 2 of Theising shows that there are two such bearing members 65 on either side of the rod 55." Paper No. 20, at p. 5-6.

Applicants suggest that the Office Action's emphasis on Figure 1 is misplaced. No portion of Figure 1 is labeled with reference number 65. In fact, Theising's Figure 1 does not contain reference number 65 at all, or any indication that Figure 1 is intended to show or display the spherical portion 65. Further, Figure 1 has no reference number at all for the portions that the Office Action states are the "clearly annular" bearings. Notwithstanding

the lack of reference number 65 in Figure 1, the Office Action appears to infer that certain unmarked portions of Figure 1 were intended to show the single spherical portion 65 shown in Figure 2 of Theising. The Office Action then appears to further infer that these unmarked portions of Figure 1 were intended to show multiple spherical portions 65 on either side of the threadable interconnection 61. Paper No. 20, at p. 5-6.

Applicants respectfully suggest that the Office Action's inferences are improper, and that the Office Action uses the disclosure of the current application and hindsight to infer elements in Theising that simply are not there. *Sensonics, Inc. v. Aerersonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551 (Fed. Cir. 1996) ("To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability").

v. **The Office Action Appears To Create A "Rotatable Portion" Element In Figure 2 Of Theising That Is Not Disclosed In Theising**

When discussing Theising, the Office Action states that this reference discloses "a locking handle (e.g., 69) which extends from a rotatable portion (e.g., the rotatable portion designated by the cross-hatched portion surrounding the threaded portion in Figure 2, which rotatable portion is shown in Figure 1 extending through both annular bearing portions)." Paper No. 20, at p. 2-3.

What Theising actually discloses is a handle assembly 53 that includes a "rotatable handle body 63 [which] includes a spherical portion 65 that rotates in a complementary shaped curved element 67 that is mounted to the first or front end of the fence channel 17.

An integral handle 69 extends in the opposite direction to the spherical portion 65 for engagement by the user." Theising, Col. 6, lines 30-35.

Accordingly, it appears that the Office Action creates an additional "rotatable portion" in the handle body 63 of Theising that is purported to be shown by a "cross-hatched portion surrounding the threaded portion in Figure 2." Paper No. 20, at p. 2-3. This "rotatable portion" that the Office Action discusses is a section of cross-hatching that is shown in Figure 2 without any reference number, and that is not discussed anywhere in the written description of Theising. Note that the only reference number that could potentially be referring to the cross-hatching is reference number 61, which the Office Action notes is the "threadable interconnection (61) of rod (55)." Paper No. 20, at p. 3.

Nowhere in Theising is there an additional "rotatable portion" element as part of the handle assembly 53 and/or handle body 63 apart from the "spherical portion 65 that rotates in a complementary shaped curved element 67." Theising, Col. 6, lines 15-33. Applicants are unsure from where in Theising the Office Action finds support for designating this cross-hatching in Figure 2 that is not labeled with any reference number a "rotatable portion" and respectfully assert that no such support exists.

To reiterate previously raised arguments, the structure recited in the present claims avoids the direct contact between the housing/fence channel and the rotating portion of the locking handle that is disclosed in Theising. *See In re Mills*, 916 F.2d 680, 682-83, 16 USPQ2d 1430 (Fed Cir. 1990) (A showing that the "prior art reference cited as anticipating a claimed invention . . lack[ed] the characteristics of the claimed invention" will "negate the assertion that the claimed invention was described in the prior art.").

Accordingly, Applicants respectfully request that the rejections based on the "rotatable portion" be withdrawn and request allowance of claims 45 and 50 because Theising does not anticipate every element of these claims. *See Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983) ("Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim. A prior art disclosure that 'almost' meets that standard . . . does not 'anticipate.'").

vi. **If The Office Action's Inferences Were Correct, The Theising Invention Would Operate Differently Than The Operation Disclosed In Theising**

The Office Action asserts that the cross-hatched portion of the handle body 63 shown in Figure 2 of Theising is a "rotatable portion designated by the cross-hatched portion surrounding the threaded portion" which "is shown in Figure 1 extending through both annular bearing portions." Paper No. 20, at p. 3. The Office Action further argues that there are also "round portion[s] (e.g., 65) on each side of the threadable interconnection" and that these "bearing portions (e.g., 65). . . include a round outer surface which slides against a curved element (67) and *an opening through which the rotatable portion extends.*" Paper No. 20, at p. 3 (emphasis added).¹

From the Office Action's comments quoted above, it appears to Applicants that the Examiner believes that the cross-hatching (called the "rotatable portion" in the Office Action) on the handle body 63 in Figure 2 of Theising essentially defines an axis through the handle body 63, and in particular through the spherical portion 65 (called the bearing

¹ Note that the Office Action appears to use the phrases "round portions" and "bearing portions" interchangeably to refer to Theising reference number 65.

portion/round portion in the Office Action) about which the spherical portion 65 rotates during operation.

If the Examiner's assertions about Theising discussed above were correct, and Applicants again respectfully suggest that they are not, then the Theising invention would operate contrary to the written disclosure of the Theising reference.

As noted above Theising discloses, and Figure 2 shows a "rotatable handle body 63 [which] includes a spherical portion 65 *that rotates in a complementary shaped curved element* 67 that is mounted to the first or front end of the fence channel 17." Theising, Col. 6, lines 30-33 (emphasis added).

From the structure shown in Figures 2 and 3 of Theising, it appears that in order for the spherical portion 65 to "rotate in" the "complementary shaped curved element 67" as described in Theising Col. 6, lines 30-33, the spherical portion 65 needs to rotate about an axis passing substantially through the center of the spherical portion 65. If an attempt was made to rotate the spherical portion 65 shown in Figures 2 or 3 around an axis that was off-center from the spherical portion 65, it appears that depending on where the axis was located, the spherical portion 65 would either rotate away from the curved element 67, or not move at all (i.e. bind against the curved element 67, preventing movement).

Applicants note that the cross-hatching on the handle body 63 of Theising's Figure 2 and Figure 3 is located off-center on the spherical portion 65. An attempt to rotate the spherical portion 65 about the axis defined by the "rotatable portion" asserted by the Office Action would result in the spherical portion 65 *not* rotating in the curved element 67 as disclosed in Theising's written description.

The position asserted in the Office Action appears to result in Theising's handle body 63 and spherical portion 65 operating contrary to the written description in Theising, lending further support to Applicants' suggestion that the Office Action misapprehends what has been disclosed by the Theising reference.

vii. Conclusion

As set forth above, and as previously acknowledged by the Examiner (Paper No. 12, at p. 5), the Theising reference fails to disclose providing an annular bearing as claimed in claims 45 and 50 of the present application. Further, Theising also fails to disclose, suggest, or teach providing at least one annular bearing that receives the rotating portion such that the handle is rotatably supported only by the annular bearing to eliminate direct contact between the rotating portion and the housing as claimed in claims 45 and 50.

Since Theising does not disclose, teach, or suggest these claim elements, Theising cannot anticipate claims 45 and 50, and these claims are not obvious in light of Theising. *See, e.g., Connell*, 722 F.2d at 1548 (Fed. Cir. 1983) ("Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim. A prior art disclosure that 'almost' meets that standard . . . does not 'anticipate.'"); *C.R. Bard, Inc.*, 157 F.3d at 1349 ("[A] finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device.")

Accordingly, Applicants respectfully request withdrawal of the rejections to claims 45 and 50 and allowance of these claims and the patent.

b. Claims 46, 48-49, and 52

Since independent claims 45 and 52 are allowable over the prior art of record, then their respective dependent claims 46, 48, and 49 which depend from claim 45, and claim 52

which depends from claim 50 are also allowable as a matter of law, because these dependent claims contain all features/elements/steps of their respective independent claims. *See In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Additionally and notwithstanding the foregoing reasons for the allowability of independent claims 45 and 50, these dependent claims recite further features/steps and/or combinations of features/steps (as is apparent by examination of the claims themselves) that are patentably distinct from the prior art of record. Accordingly, there are additional reasons why these dependent claims are allowable.

B. Response To Claim Rejections Under 35 U.S.C. Section 103

Claim 47, which depends from independent claim 45, and claim 51 which depends from independent claim 50 have been rejected under 35 U.S.C. §103 as purportedly being obvious in light of Theising combined with Tautz, U.S. Patent 1,938,548.

Applicant respectfully traverses these rejections as well. It is well established at law that for a proper rejection of a claim under 35 U.S.C. §103, the Office Action must establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837, F.2d 1071 (Fed. Cir. 1988).

Accordingly, to make a *prima facie* case for obviousness, there must be some prior art teaching or established knowledge that would suggest to a person having ordinary skill in the pertinent art to fill the voids apparent in the applied reference. *See, e.g., In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q. 871,

881 (C.C.P.A. 1981). It is respectfully asserted that no such *prima facie* case has been made in the outstanding Office Action.

As set forth above, independent claims 45 and 50 are not anticipated by the Theising reference, nor are claims 45 and 50 obvious in light of Theising. Nothing in Theising discloses, teaches, or suggests all of the elements of claims 45 and 50. Since claims 45 and 50 are allowable, dependent claim 47 which depends from claim 45, and dependant claim 51 which depends from claim 50 are also allowable as a matter of law, because these dependent claims contain all features/elements/steps of their respective independent claim. See *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Additionally and notwithstanding the foregoing reasons for the allowability of claims 45 and 50, these dependent claims recite further features/steps and/or combinations of features/steps (as is apparent by examination of the claims themselves) that are patentably distinct from the prior art of record. Accordingly, there are additional reasons why these dependent claims are allowable.

CONCLUSION

In light of the foregoing, and for at least the reasons set forth above, Applicants respectfully submit that all rejections have been traversed and that the pending claims 45-52 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 384-2838.

PETITION FOR EXTENSION OF TIME

Pursuant to 37 C.F.R. § 1.136(a), Applicant petitions for an extension of time of one month in which to respond to the Office Action dated September 23, 2003. Any fee required for said extension of time are hereby authorized to be charged to deposit account no. 502889. It is not believed that any additional fees are required. However, in the event that any additional fees are required and/or are necessary to allow consideration of this paper, such fees are also hereby authorized to be charged to deposit account no. 502889.

Respectfully submitted,



Robert B. Dulaney 
Reg. No. 47,539

Home Depot USA, Inc.
2455 Paces Ferry Rd
Building C-19
Atlanta, Georgia 30339
(770) 384-2838